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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/025,947

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Hsuan-Yin Lan-Hargest

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EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

06/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/025,947	<b>Applicant(s)</b> LAN-HARGEST ET AL.	
	<b>Examiner</b> Paul A. Zucker	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/3/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

**Current Status**

1. This action is responsive to Applicants' amendment of 16 March 2009.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.
4. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 6 of the previous Office Action mailed 16 December 2008 is withdrawn in response to Applicant's amendment.
5. The rejections under 35 USC § 102, set forth in paragraphs 7 and 8 of the previous Office Action mailed 16 December 2008 are withdrawn in response to Applicant's amendment.

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**New Rejections**  
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**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 91-94, 96,97 and 99-101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 91 recites both of the limitations "L is a straight C<sub>3-6</sub> hydrocarbon chain" in line 14 and "when L is C<sub>3-7</sub>" in line 24. It is therefore unclear what Applicants' intended definition for L is. Claim 91 and its dependents are therefore rendered indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 22, 80, 91, 102 and 103 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the newly added limitation excluding the subgenus defined when “L is  $G_4$  or  $G_5$  C<sub>3-7</sub> and contains one triple bond or one or two double bonds” in the application as filed. A search of the entire failed to find support for the sub range “C<sub>3-7</sub>”. The currently amended claim language constitutes new matter because the written description of the instant specification does not “reasonably lead” those skilled in the art to this particular subgenus of compounds. (MPEP 2163.05).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-5, 12, 13, 22, 80-84, and 88 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Meyer et al (European Journal of Medicinal Chemistry,  $\omega$ -Substituted Alkyl Carboxylic Acids as Antidiabetic and Lipid-lowering Agents, 1998, pages 775-787). Meyer discloses (Page 778, Figure 4, and page 785, column 1, section 6.1.18), the compound **24** (E) 2, 2-dichloro-12-phenyl-11-dodecenoic acid and its lithium salt in aqueous solution corresponding to a pharmaceutical composition. 2,2-dichloro-12-phenyl-11-dodecenoic acid corresponds to instantly claimed compounds in which A is phenyl (unsubstituted), L is a dihalo-substituted  $C_{12}$  trans olefin,  $Y_1, Y_2 = \text{a bond}$  (or L is a  $C_{11}$  all trans diene,  $Y_1 = \text{a bond}$ ,  $Y_2 = \text{CH}_2$ ),  $X_1, X_2 = \text{O}$ . Meyer therefore anticipates claims 1-5, 12, 13, 22, 80-84, and 88
9. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-84, 87-90, 91-94, 96, 97 and 99-101 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Scholz (Liebigs Annalen der Chemie,  $\beta$ -Keto Sulfones as Ethylene Carbanion Equivalents: The Synthesis of Unsaturated Carboxylic acids, 1984, (2), pages 264-272). Scholz discloses (Abstract and structure for RN 89730-29-0) the compounds 8-phenyl-6-octenoic acid and 13-phenyl-11-tridecenoic acid and their solutions as salts in ethanol corresponding to pharmaceutical compositions. The Examiner presumes at least some E olefin is present in a mixture of geometric isomers. 8-phenyl-6-octenoic acid corresponds to an instantly claimed compound in which A is phenyl (unsubstituted), L is a  $C_{8-6}$  mono alkene substituted with monocyclic aryl,  $Y_1, Y_2 = \text{a bond or } -\text{CH}_2-$  and  $X_1, X_2 = \text{O}$ . 13-phenyl-11-tridecenoic acid corresponds to an instantly claimed compound in which A is phenyl (unsubstituted), L is a  $C_{13-11}$  mono

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alkene substituted with monocyclic aryl,  $Y_1, Y_2 =$  a bond or  $-CH_2-$  and  $X_1, X_2 = O$ .

Scholz therefore anticipates claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-84, 91-94, 96, 97 and 99-101. Note: claims 91-94, 96, 97 and 99-101 are included due to their indefinite nature as set forth above.

10. Claims 1-5, 7, 8, 80-86, 89 and 90 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Strunz et al (Canadian Journal of Chemistry, Expedient Synthesis of Unsaturated Amide Alkaloids from Piper spp: Exploring the Scope of Recent Methodology, 1996, (74), pages 419-432). Strunz discloses (Page 429, paragraph bridging columns 1 and 2) the compound 9-(3', 4'-methylenedioxyphenyl)-nona-2E, 4E, 8E-trienoic acid and its lithium salt in aqueous acetone corresponding to a pharmaceutical composition. 9-(3', 4'-methylenedioxyphenyl)-nona-2E, 4E, 8E-trienoic acid corresponds to an instantly claimed compound in which A is aryl, L is a  $C_8$  triene substituted with monocyclic aryl,  $Y_1, Y_2 =$  a bond or and  $X_1, X_2 = O$ . Strunz therefore anticipates claims 1-5, 7, 8, 80-86, 89 and 90

### **Conclusion**

11. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-84, 87-94, 96, 97 and 99-103 are finally rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. Zucker/  
Primary Examiner, Art Unit 1621